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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/880,149	06/14/2001	John H. Kenten	2757-5	7213

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EXAMINER

WINKLER, ULRIKE

ART UNIT	PAPER NUMBER
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1648

12

DATE MAILED: 05/20/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/880,149

Applicant(s)

KENTEN ET AL.

Examiner

Ulrike Winkler

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 March 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 24-30, 36, 37, 40 and 43 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 24-30, 36, 37, 40 and 43 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) ☐ Other: _____

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DETAILED ACTION

The Amendment filed March 3, 2002 (Paper No. 11) in response to the Office Action of October 3, 2002 is acknowledged and has been entered. Claim 43 has been added. Claims 24-30, 36, 37, 40 and 43 are pending and are currently being examined.

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office Action.

Specification

The office acknowledges receipt of the new abstract.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

The rejection of claims 24-30, 36, 37 and 40 under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for ubiquitination of a protein using a compound in a cell lysate assay system, does not reasonably provide enablement for ubiquitination of a compound within a cell (claims 24, 25, 29, 36, 37 and 40) and for the use of the compound as a pharmacological agent in a patient (claims 26-28 and 30) is **withdrawn** in view of applicant's arguments.

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New Rejection:

Claims 24-30, 36, 37, 40 and 43 rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

(MPEP 2163) The satisfaction of the enablement requirement does not satisfy the written description requirement. See *In re Barker*, 559 F.2d 588, 591, 194 USPQ 470, 472 (CCPA 1977) (a specification may be sufficient to enable one skilled in the art to make and use the invention, but still fail to comply with the written description requirement). See also *In re DiLeone*, 436 F.2d 1404, 1405, 168 USPQ 592, 593 (CCPA 1971). For the written description requirement, an applicant's specification must reasonably convey to those skilled in the art that the applicant was in possession of the claimed invention as of the date of invention. *Regents of the University of California v. Eli Lilly & Co.*, 119 F.3d 1559, 1568, 43 USPQ2d 1398, 1405 (Fed. Cir. 1997); *Hyatt v. Boone*, 146 F.3d 1348, 1354, 47 USPQ2d 1128, 1132 (Fed. Cir. 1998).

In this instance applicants are claiming a fusion molecule/product wherein neither the recognition site [E2 and/or E3 elements] or the binding element [ubiquitination recognition element] have been sufficiently described in terms of their structure and function. Applicants are claiming the method of using a product, where the product is defined based on function alone without providing any information regarding the structure. The "ubiquitination recognition element" being recited is indeterminate relative to the target to which it binds which itself is indeterminate. Claiming a product based on function does not provide sufficient description of the product. It has been well known that minor structural differences even among structurally related compounds or compositions can result in substantially different biological or pharmacological activities. Therefore, structurally unrelated "molecules" encompassed by the

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claimed invention other than those disclosed in the specification as filed would be expected to have greater differences in their structural and functional characteristics and attributes. Mere idea or function is insufficient for written description; isolation and characterization at a minimum are required

"a mere wish or plan" for obtaining an invention is not enough to comply with § 112, ¶ 1 (*Regents of the University of California v. Eli Lilly & Co.*, 119 F.3d 559, at 1566).

The Guidelines for the Examination of Patent Applications Under the 35 U.S.C. 112, ¶ 1 "Written Description" Requirement make clear that if a claimed genus does not show actual reduction to practice for a representative number of species; then the Requirement may be alternatively met by reduction to drawings, or by disclosure of relevant, identifying characteristics, i.e., structure or other physical and or chemical properties, by functional characteristics coupled with a known or disclosed correlation between function and structure, or by a combination of such identifying characteristics, sufficient to show the applicant was in possession of the genus (Federal Register, Vol. 66, No. 4, pages 1099-1111, Friday January 5, 2001, see especially page 1106 column 3).

The instant specification and claims do not provide sufficient functional and structural characteristics of the recognition element or the ubiquitination system coupled with a known or disclosed correlation between function and structure. Since the disclosure fails to describe the common attributes or characteristics that identify members of the group, the disclosure of particular compounds is insufficient to describe the genus of molecules, encompassed by the claimed invention.

In this instance applicants are claiming a fusion molecule/product wherein neither the recognition site or the ubiquitination system binding element have been sufficiently described in terms of their structure and function. The "ubiquitination recognition element" being recited is indeterminate relative to the target to which it binds which itself is indeterminate. In order to overcome the written description deficiency applicant may:

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(1) define the structure of the target that is critical for the binding and is shared by all members of "the family" of proteins which make up the ubiquitination system; or

(2) applicants may specifically recite the "ubiquitination recognition elements" disclosed in the specification. If applicants choose this route, the compounds will not be restricted based on their structural differences.

Therefore, there is lack of written description in the instant invention for the claimed method of reducing a protein inside a cell.

Claims 24 and 36 recites the limitation "the ubiquitination system" in the claim. There is insufficient antecedent basis for this limitation in the claim.

Conclusion


No claims allowed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ulrike Winkler, Ph.D. whose telephone number is 703-308-8294. The examiner can normally be reached M-F, 8:30 am - 5 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Housel, can be reached at 703-308-4027.

The fax phone numbers for the organization where this application or proceeding is assigned are 703-308-4242 for informal communications use 703-308-4426.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0196.


ULRIKE WINKLER, PH.D.
PATENT EXAMINER 5/19/03